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11/13/02

Docket No. 53196-00002  
0968/P/JO

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
Vladimir Nikolaevich PAK et al.

Serial No.: 09/885,645

Confirmation No. 4188

Filed: June 20, 2001

) Examiner: Anthony C. Caputa

) Group Art Unit: 1642

For: METHOD FOR TREATMENT OF MALIGNANT NEOPLASMS AND A COMPLEX  
PREPARATION HAVING ANTIMALIGNANT ACTIVITY

BOX: NON-FEE AMENDMENT  
Commissioner for Patents  
Washington, D.C. 20231

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CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being deposited postage paid with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231	
on	10 - 31 - 02
Signature	
Cheryl Gibson	

Dear Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

This Response is being filed in response to the Restriction Requirement mailed October 1, 2002. Applicants respond as follows:

Restriction to one of the following inventions has been required under 35 U.S.C. § 121:

- I. Claim 1, drawn to a method of treatment of malignant neoplasms.
- II. Claims 2-4, drawn to a complex preparation.

The Examiner has stated that Groups I and II are distinct from one another because "...Inventions I and II are related as product and process of use. The Inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can

be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the alpha-fetoprotein of Invention II can be used in the materially different process of affinity purification of antibodies.”

Applicants wish to point out to the Examiner the Preliminary Amendment filed along with this Response. As explained in the Remarks of the Preliminary Amendment, Applicant has amended claims 1-4 and has added new claims 5-7. In accordance with the claims as pending following the Preliminary Amendment, Applicants hereby elect claims 2-4. In addition, Applicants respectfully request that the Examiner reconsider the Restriction Requirement on the basis that there is no additional burden to search and examine the two groups of claims that are currently pending.

Applicants respectfully submit that, if currently-pending claim 2 is found to be allowable, claims 1 and 5-7 will also be allowable as a matter of law. Thus, search and examination can proceed on the basis of currently-pending claim 2. Applicant respectfully submits that there is no additional burden on the part of the USPTO to keep claims 1 and 5-7 together with claims 2-4. MPEP § 803 provides that, if the search and examination of claims can be made without serious burden, the examiner **must** examine the claims on the merits, even if the application includes claims to independent or distinct inventions.

In addition, the MPEP provides for rejoinder of claims that are subject to a Restriction Requirement. MPEP § 821.04 provides that non-elected process claims can be rejoined after an

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elected product claim has been allowed, if the process claims depend on or otherwise include all the limitations of the allowable product claim. Applicant respectfully submits that this rule applies here. Therefore, it is proper to keep claims 1 and 5-7 together with claims 2-4. Applicant respectfully requests the withdrawal of the Restriction Requirement.

Applicants respectfully submit that they have addressed all of the Examiner's rejections. If any questions or issues remain that the Examiner believes would be advanced by a conference with Applicants' attorney, the Examiner is invited to contact the undersigned at the number below.

The one-month time period expires on November 1, 2002. Since this response is being filed within the one-month time period, no Petition For Extension of Time is necessary. Therefore, Applicants respectfully submit that no fees are due in connection with this Response.

Respectfully submitted,

JENKENS & GILCHRIST,  
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1642

PATENT APPLICATION  
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Signature

10-31-02  
Chey Hilson

AMENDMENT TRANSMITTAL LETTER

Dear Sir:

This is a response/amendment/letter in the above-identified application and includes the transmitted herewith attachment(s) of the same date and subject which is/are incorporated hereunto by reference. The signature below is to be treated as the signature to the attachment(s) in absence of a signature thereto.

Transmitted herewith in the above-identified application is/are:

1. Amendment Transmittal Letter;
2. Response To Restriction Requirement;
3. Preliminary Amendment with attached Exhibits A and B; and
4. Acknowledgment Postcard.

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Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.

A verified statement claiming small entity status under 37 CFR 1.9 and 1.27 is enclosed.

No additional fee is required.

The Fee for entering the attached Amendment is calculated below:

	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST # PREVIOUSLY PAID FOR	PRESENT EXTRA	SMALL ENTITY RATE	LARGE ENTITY RATE	
TOTAL CLAIMS	<u>7</u>	<u>20</u> (at least 20)	= (at least 0)	x9 = OR	x18 =	\$ _____
INDEP. CLAIMS	<u>2</u>	<u>3</u> (at least 3)	= (at least 0)	x39 = OR	x84 =	\$ _____
FIRST PRESENTATION OF <u>PROPER</u> MULTIPLE DEPENDENT CLAIMS (leave blank if this is a <u>reissue</u> appln)			+130	= OR	+280	= \$ _____
<b>FEE FOR CLAIM AMENDMENTS</b>						
						\$ _____
						\$ _____
						\$ _____
						\$ _____
						\$ _____

Petition is hereby made under 37 CFR 1.136(a) to extend the original due date to cover the date this response is filed for which the requisite fee is attached:

	Small Entity	Large Entity
One Month	<u>      </u> \$ 55	<u>      </u> \$110
Two Months	<u>      </u> \$200	<u>      </u> \$400
Three Months	<u>      </u> \$460	<u>      </u> \$920
Four Months	<u>      </u> \$720	<u>      </u> \$1440
Five Months	<u>      </u> \$980	<u>      </u> \$1960

ADDITIONAL FEE FOR EXTENDED RESPONSE \$ \_\_\_\_\_

Applicant has not been notified that the requested extension will not be permitted. The present application is not involved in an interference declared pursuant to 37 CFR 1.611.

**TOTAL FEES** \$0

A check in the amount of \$ to cover the TOTAL FEE is attached. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-0447.